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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/770,722   | 02/03/2004  | Gerard Warmerdam     | 5084                | 2287             |
| 7590   | 08/11/2005  |                      | EXAMINER            |                  |
| RICHARD ESTY PETERSON<br>PATENT ATTORNEY<br>1905 - D PALMETTO AVENUE<br>PACIFICA, CA 94044 |             |                      | HOOK, JAMES F       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER /   |
|  |             |                      | 3754                |                  |
| DATE MAILED: 08/11/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/770,722             | WARMERDAM, GERARD   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | James F. Hook          | 3754                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 May 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4,7,9 and 10 is/are rejected.
- 7) Claim(s) 2 and 8 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Claims 5 and 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on August 9, 2004.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 4, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathison in view of Warmerdam and Tash (356). The patent to Mathison discloses the recited pipe plug comprising a radially expandable plug body 13 (fig 10) having end portions and a central portion, where the outer surface has a series of alternating raised ribs, end caps 11,12 formed of rigid material are inserted into the end portions, the end caps are provided with a circumferential groove between structures 17 and 18 having a band 16 to hold the body onto the end caps via the groove and a band 14 provided there around the sleeve also aiding in holding the plug body in place on the end caps, where the body is compressed into the groove, an air fitting 20 connected to a source of air 23 is connected through one end cap to allow the body to be expanded, where as seen in figure 10 the ribs have substantially an equal height to width. The patent to Mathison discloses all of the recited structure with the

exception of swaging the bands to the end caps, and providing textured bands between the ribs. The patent to Warmerdam discloses the recited inflatable plug comprising an expandable body 14, end caps 34 provided with profiled structure to capture and hold the end of the body, a fitting for a hose 20 to inflate the body through an end cap, and a band 16,16a is provided to be swaged onto the end caps to hold the body in place. It would have been obvious to one skilled in the art to modify the end caps in Mathison to be provided with a swaged band to hold the expandable body to the end cap as suggested by Warmerdam as such would be a cheaper manner to form the connection between body and end cap in that less parts and assembly would be required. The patent to Tash (356) discloses the recited pipe plug comprising an expandable plug body 16 provided with end portions and a central portion, raised rib sections 26 are provided and a textured set of bands 28 is provided in an alternating fashion between the rib sections 26, end caps 44,46 and 38 are provided with an inflation means 40 in one of the end caps, where the ribs are seen in the figures to be substantially equal in height and width. It would have been obvious to one skilled in the art to modify the plug body in Mathison by providing a textured surface between ribs as suggested by Tash as such would reduce frictional contact for insertion of the plug and thereby allow for easier insertion of the plug thereby saving time and money.

Claims 1, 3, 4, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tash (356) in view of Warmerdam. The patent to Tash disclose all the structure set forth above with the exception of swaging bands to the end caps to hold the body to the end caps. The patent to Warmerdam discloses the structure above

where the inclusion of a groove on the cap instead of the band is merely a reversal of parts and an obvious expedient. It would have been obvious to one skilled in the art to modify the end caps in Tash to be inserted into the plug body and providing swaging bands to hold the body to the end caps as suggested by Warmerdam as such would reduce costs by lessening the number of parts required to connect the body to the end caps and such would be more secure and prevent premature failure, where the use of a groove on the end cap is merely a choice of mechanical expedients and a mere reversal of parts.

Claims 1, 3, 4, 7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathison in view of Warmerdam and Vanderlans. The patent to Mathison discloses the recited pipe plug comprising a radially expandable plug body 13 (fig 10) having end portions and a central portion, where the outer surface has a series of alternating raised ribs, end caps 11,12 formed of rigid material are inserted into the end portions, the end caps are provided with a circumferential groove between structures 17 and 18 having a band 16 to hold the body onto the end caps via the groove and a band 14 provided there around the sleeve also aiding in holding the plug body in place on the end caps, where the body is compressed into the groove, an air fitting 20 connected to a source of air 23 is connected through one end cap to allow the body to be expanded, where as seen in figure 10 the ribs have substantially an equal height to width. The patent to Mathison discloses all of the recited structure with the exception of swaging the bands to the end caps, and providing textured bands between the ribs. The patent to Warmerdam discloses the recited inflatable plug comprising an

expandable body 14, end caps 34 provided with profiled structure to capture and hold the end of the body, a fitting for a hose 20 to inflate the body through an end cap, and a band 16,16a is provided to be swaged onto the end caps to hold the body in place. It would have been obvious to one skilled in the art to modify the end caps in Mathison to be provided with a swaged band to hold the expandable body to the end cap as suggested by Warmerdam as such would be a cheaper manner to form the connection between body and end cap in that less parts and assembly would be required. The patent to Vanderlans discloses the recited pipe plug comprising an expandable plug body 10 provided with end portions 17,18 and a central portion, raised rib sections 11 are provided and a textured band 20 is provided in an alternating fashion between the rib sections 11, where the ribs are seen in the figures to be substantially equal in height and width. It would have been obvious to one skilled in the art to modify the plug body in Mathison by providing a textured surface between ribs as suggested by Vanderlans as such would allow for easy insertion but still hold the plug in place against head pressure in sewer pipes where such would insure for a faster insertion while still providing greater resistance to head thereby saving money in installation time required.

### ***Response to Arguments***

Applicant's arguments filed May 31, 2005 and February 7, 2005 have been fully considered but they are not persuasive. With respect to Tash, the grid pattern is considered the equivalent of a textured band especially when no specific type of texture is claimed in the independent claims to which Tash is applied, and since the plugs in

question are defined as being fabric, the used of the definition based on cloth is not considered to be applicable only the broad definition that of visual or tactile surface characteristics, and with no specific characteristic claimed in the independent claim, any surface characteristic can be considered to meet this limitation including the grid pattern of Tash. Tash shows ribs on either side of the textured bands and this is considered to be alternating. The arguments are more detailed than the claim language. With respect to the size of Tash and it's intended use in specific size pipes, such is not a persuasive argument when sizes are not claimed and such is used merely to teach changing the surface of the plug for different effect. With respect to Pottorf, the argument is moot since this rejection has been dropped. With respect to the arguments directed toward the combination of Tash with Mathison, with respect to insertion, the motivation to combine need not be the same as applicants, and upon providing Mathison with the surface features taught by Tash would provide more gripping and friction inherently once the plug were inflated, the fact that the ribs assist in insertion of Tash does not mean that once inflated such wouldn't play a role in holding the plug in place as well, and it is noted that the claims do not require a specific friction requirement either, just an improved resistance to slippage which the textured band of Tash would provide to Mathison during use regardless of whether such also assists in insertion.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Egnor disclosing a state of the art inflatable plug.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

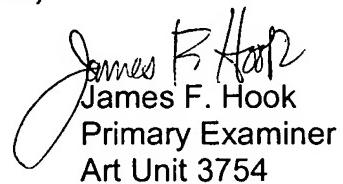
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James F. Hook  
Primary Examiner  
Art Unit 3754

JFH